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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/502,542	02/10/2000	Bruce L Davis	60109	5321
23735 7590 04/21/2008 DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008				
EXAMINER				
FADOK, MARK A				
ART UNIT		PAPER NUMBER		
3625				
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04/21/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/502,542

Applicant(s)

DAVIS ET AL.

Examiner

MARK FADOK

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-7 and 9-32 is/are pending in the application.
- 4a) Of the above claim(s) 1, 3-7, 9, 12-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7, 10, 11 and 20-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date _____
- 6) ☐ Notice of Informal Patent Application
- 7) ☐ Other: _____
- 8) ☐ Paper No(s)/Mail Date 9/10/2007

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 9/10/2007 has been entered.

The examiner has considered the amendment to the specification which adds the language of the original claims 1,3,7 and 8 to page 2 of the specification and finds the amendment to be acceptable. Therefore the specification amendment filed 9/10/2007 is hereby entered.

Applicant has elected Group I with traverse, the examiner has carefully considered applicant's remarks and has determined that claims 1,7,10,11,20-32 constitute a single invention, while claims 3-7,9,12-19 are a separate invention that would require a separate search and consideration since these inventions found in claims 3-7,9,12-19 all include the feature of providing a virtual shopping aisle. Applicant argues that the extra inventions would not cause an undue burden since there has already been a series of RCEs. The examiner notes that the applicant has added new features to the claims that have been already examined and considered by the Board of Appeals which affirmed the examiner. The examiner notes that the restriction is done

apriori and therefore the precise burden upon the examination cannot be determined and since these claims contain new features a new search will be required, therefore the restriction is considered proper.

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 29, 30 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Trotta, Jr. (US 5,595,264).

In regards to claim 29, Trotta Jr. discloses a method that includes sensing machine-readable data to compile a list of products, and using said list to order products from a remote location for subsequent delivery, an improvement comprising sensing said machine- readable data from sample products that are displayed in a mall storefront facility for this purpose (abstract), wherein users can inspect, handle, and sense machine-readable data from the sample products at said facility (col 4, lines 48-67), and orders therefore can later be fulfilled from the remote location based on the list generated thereby (col 5, lines 30-45).

In regards to claim 30, Trotta Jr. discloses a method comprising: providing a mall storefront that displays certain items offered for sale, but does not stock an inventory from which sales of these items can be fulfilled (col 4, lines 48-67); providing a sensor device to a customer (col 3, line 40-col 4, line 30); and allowing the customer to handle the displayed products and sense machine readable data from products of interest to the customer, generating an electronic list (col 5, lines 1-45).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1,7,10,11,20,21,23,24,25,27,31 and 32 are rejected under 35

U.S.C. 103(a) as being unpatentable over Trotta Jr. in view of Cybul et al (US 6,246,997) and further in view of Official Notice.

In regards to claim 1, Trotta Jr. discloses a method comprising:

sensing indicia from selected items offered for sale in a bricks and mortar store, and compiling a list therefrom (Trotta, FIG 2);

storing said list in a data structure associated with a user (col 1, lines 47-63);

Trotta teaches collecting information about a shopping experience, but does not specifically mention "said user later signing on to an on-line store or virtual storefront over the internet, from a user's computer and said on-line store or virtual storefront using said list to present to said user a customized selection of items on a display of the user's computer". Cybul teaches said user later signing on to an on-line store or virtual storefront over the internet, from a user's computer and said on-line store or virtual storefront using said list to present to said user a customized selection of items on a display of the user's computer (Cybul abstract). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Trotta later signing on to an on-line store or virtual storefront over the internet, from a user's computer and said on-line store or virtual storefront using said list to present to said user a customized selection of items on a display of the user's computer as is taught by

Cybul (FIG 1, List builder tool), because magnitudes make the first time shopping experience overwhelming (Cybul; col 1, lines 20-30)

The combination of Trotta and Cybul teaches through use of a user interface of the user's computer, receiving input from the user identifying a subset of items from said customized selection of items, in connection with a purchase transaction of said subset of items from the on-line store or virtual, from a user's computer and said on-line store or virtual storefront using said list to present to said user a customized selection of items on a display of the user's computer storefront, but does not specifically mention that the customer logs on. The examiner takes official notice that logging on to system to register oneself was old and well known in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include in Trotta and Cybul logging in to retain the information, because this provides a proven method for identifying the individual that will permit the system to pull up the information pertinent to the user.

wherein the sensing of item indicia in the bricks and mortar store facilitates user shopping in an on-line store or virtual storefront, by enabling customization of the selection of items presented to the user by said online store or virtual storefront (Cybul, FIG 1).

In regards to claim 7, the combination of Trotta Jr. and Cybul discloses a method comprising:

through a user-interface presented by a shopper's computer, signing-in a shopper to an on-line store or virtual storefront (see response to claim 1);

logging the shopper's habits or preferences exhibited in the on-line store or virtual storefront, in one or more database records associated with that shopper (Cybul, FIG 1, item 28); and

Cybul teaches using information from both an online shopping experience and a physical store and Trotta teaches using information stored to provide information to the shopper in a brick and mortars store. It would have been obvious to include in Trotta the information that was available through Cybul, because this will provide more focused advertising to entice the user to buy more product (Trotta, col 7, line 3-20)

In regards to claim 10, the combination of Trotta Jr. and Cybul teaches in which the sensing comprises sensing said selected items along aisles at which said items are displayed, away from a checkout stand (Trotta, col 4, lines 48-67).

In regards to claim 11, the combination of Trotta Jr. and Cybul teaches a sensing device, but does not specifically mention that the device being sensed is an RFID device. It was old and well known in the art at the time of the invention to sense products using an RFID device. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Trotta Jr. and Cybul sensing using RFID, because this would improve the capability of Trotta Jr. and Cybul systems by including additional capability to sense products that may only have RFID devices.

In regards to claim 20, the combination of Trotta Jr. and Cybul discloses a method of facilitating on-line shopping comprising:

collecting data about products of interest during a shopper's visit to a bricks and mortar store (see response to claim 1);

the shopper later signing-on to an on-line store or virtual storefront over the internet, from a shopper's computer, to commence an online shopping session; and

using the collected data in said shopper's online shopping session with the online store or virtual storefront (see response to claim 1);

In regards to claim 21, the combination of Trotta Jr. and Cybul teaches wherein at least certain of the products of potential interest are not purchased by said shopper during said visit to said store (Trotta, FIG 2).

In regards to claim 23, the combination of Trotta Jr. and Cybul teaches wherein the data collection includes shopper use of a sensor device in the aisle of the store to collect data relating to a product of interest (Trotta, FIG 2).

In regards to claim 24, the combination of Trotta Jr. and Cybul teaches wherein at least one of said items is sensed while located in an aisle of the store, rather than at checkout (Trotta, FIG 2).

In regards to claim 25, the combination of Trotta Jr. and Cybul teaches wherein the sensing of at least one item occurs without an associated purchase transaction (Cybul, col 1, lines 33-41).

In regards to claim 27, the combination of Trotta Jr. and Cybul teaches in which the on-line shopping session is with a first vendor, yet products included on the recalled list include products that the user has not purchased from the first vendor (see response to claim 26).

In regards to claim 32, Trotta Jr. discloses a method comprising:
in a mall, providing a facility at which a collection of sample products is displayed and can be handled by customers but said samples are not available for customers to purchase and take home (col 4, lines 48-67);

rather, said facility provides an opportunity for the consumers to handle said products and use handheld appliances to sense machine-readable data from said products (col 5, lines 1-30),

Trotta teaches collecting information into a list that tracks the customers spending habits (col 7, lines 4-15), but does not specifically mention that the sensed data is then used to place online orders for such products. Cybul teaches collecting scanned data from a local store to create a shopping list that can be used for online shopping (col 1, line 33 to col 2, line 67). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Trotta, Jr. providing

information about products for later use in online shopping, because online shopping accounts for a significant amount of sales and providing the information in an online manner would increase sales for merchants that expanded into the online sales model.

Further, it is noted that all of the elements of the cited references perform the same function when combined as they do in the prior art . Thus such a combination would have yielded predictable results (see *Sakraida*, 425 US at 282, 189 USPQ at 453. Since the independent claims only unite old elements with no change in there respective functions the claimed subject matter would have been obvious under KSR, 127 S. Ct at 1741, 82 USPQ2d at 1396.

Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex arte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

wherein the facility requires much less space than would a facility that provided an inventory of such products for the customers to purchase and take home (col 4, lines 48-67).

In regards to claim 31, the combination of Trotta Jr. and Cybul teaches fulfilling said purchases as if the purchases were made online, by passing said list to a fulfiller (see response to claim 32 and col 2, lines 55-67, list of items sent to the retrieval area which is considered the fulfiller).

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Trotta Jr. in view of Cybul et al (US 6,246,997) in view of Official Notice and further in view of Deaton (US 6,993,498)

In regards to claim 26, the combination of Trotta Jr. and Cybul teaches gathering information to facilitate a later transaction, but does not specifically teach "the recalled list is used by a second vendor different from the first, to present a customized selection of items in an on-line store or virtual storefront. Deaton teaches utilizing a shopping list to effect a later transaction (col 2, lines 25-35). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Trotta and Cybul the recalled list being used by a second vendor different from the first, to present a customized selection of items in an on-line store or virtual storefront, because this will provide comparison information for a more informed decision.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Trotta Jr. in view of Cybul et al (US 6,246,997) in view of Official Notice, in view of Logan (US 5721827).

In regards to claim 28, the combination of Trotta Jr. and Cybul discloses a method of shopping for products using an online storefront, comprising:
sensing machine readable data from physical products selected by a shopper,

and adding such products to a favorites list associated with that shopper (the examiner considers the a favorites list to any list established by the buyer during a shopping experience);

storing said favorites list in a database accessible to an online storefront web server;

soliciting a user ID from the shopper during a visit to the online storefront by the shopper,

the online storefront being presented using a display of a shopper' s computer;
by reference to the user ID, recalling that shopper's favorites list from the database, and populating the online storefront with a personalized universe of products corresponding to that shopper;

the shopper then identifying products to be purchased from this personalized universe of products, through interaction with a user interface presented on said the display of the shopper' s computer (see response to claim 1-27); and

The combination of Trotta and Cybul teach ordering products online, but does not specifically mention "arranging for delivery of the identified products to the shopper's home". The examiner takes official notice that arranging for delivery of the identified products to the shopper's home was old and well known in the art. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include in Trotta and Cybul arranging for delivery of the identified products to the shopper's home, because this would assure that the purchaser received the product.

Applicant may argue that there is no user ID or display mentioned, however, Logan teaches displaying a personalized catalog on a display based on a user password during a log on step (FIG 1, abstract, claim 1 and col 10, lines 9-20). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include authenticating the user and providing personalized information to a user on a display, because, this would provide some notoriously well known functionality to the system and provide an effective means for viewing and protecting the users personalized catalog or products.

wherein compilation of the favorites list by reference to physical products selected by a shopper - rather than exclusively by cumbersome navigation and selection of products through a computer user interface - alleviates a hurdle that has prevented more widespread adoption of on-line product shopping by certain segments of the public (this feature is considered a benefit that does not impart a functional step in the method. Since the feature only describes an intended result little patentable weight is given to this feature).

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Trotta Jr. in view of Cybul et al (US 6,246,997) in view of Official Notice, and further in view of Rosenberg (US 5,933,814).

In regards to claim 22, the combination of Trotta and Cybul teach collecting information about products and saving them to a database, but does not specifically mention the data collection includes shopper activation of a shelf-mounted reader

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associated with a product of interest. Rosenberg teaches data collection includes shopper activation of a shelf-mounted reader associated with a product of interest (FIG 1). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Trotta and Cybul, data collection includes shopper activation of a shelf-mounted reader associated with a product of interest, because this would save money by not having to provide scanners to the shoppers.

Further, it is noted with regards to the above combinations that all of the elements of the cited references perform the same function when combined as they do in the prior art . Thus such a combination would have yielded predictable results (see Sakraida, 425 US at 282, 189 USPQ at 453. Since the independent claims only unite old elements with no change in there respective functions the claimed subject matter would have been obvious under KSR, 127 S. Ct at 1741, 82 USPQ2d at 1396.

Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex arte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

Response to Arguments

Applicant's arguments with respect to claims 1,7,10,11,20-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300 [Official communications; including
After Final communications labeled
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For general questions the receptionist can be reached at
571.272.3600

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/Mark Fadok/

Primary Examiner, Art Unit 3625